UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/665,097	BARRUS ET AL.
	Examiner	Art Unit	
	Nathan Hillery	2176	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 October 2007_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-79_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-79_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _10/30/07_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed on 10/30/07.

2.   Claims 1-79 are currently pending in the case, with claims 1, 42, 44, and 63

being the dependent claims.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

10/30/07 has been entered.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1 – 6, 19, 20, 27 – 32, 35 – 49, 54, 55, 59 – 68, 73 and 74 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Davies et al. (US 20020085759 A1),

and in further view of Klotz, Jr. et al. (US 5682540 A).

Regarding independent claim 1,

Davies et al. teach that once the glyph sticker pattern has been located, the data

within the glyph field is then decoded. The data is then associated with a desired

service (paragraph block 0052), which meet the limitation of **locating, on the**

document index image, an image of a first sticker specifying an action;

Davies et al. teach that while the user interface tag of the invention is illustrated

in FIG. 1 as an adhesive sticker capable of being applied to documents, it should be

observed that the pattern may also be applied to cover sheets capable of being

associated with a document (paragraph block 0035), which meet the limitation of

determining that the first sticker specifies a first action be performed on the first

stored document based on a location of the first sticker with respect to the first

graphic representation; and

Davies et al. teach that a system permits a user to specify an action or a service

to be performed simply by applying a sticker to the document and placing it into a bin to

be scanned (paragraph block 0012), which meet the limitation of **performing the first**

action to cause a change to the first stored document.

Davies et al. do not explicitly teach **locating, on the document index image, at**

least a first graphic representation of a first stored document and receiving an

image of a document index, the document index comprising a plurality of graphic

representations of documents, wherein each graphic representation uniquely

identifies a document.

However, Davies et al. do teach that when the user wishes to process a

document, he places the document into a scanner. The scanner reads the document

and formulates a bitmap representative of the document (paragraph block 0043) and

that while the invention is illustrated as being applied to documents, it should be

observed that the pattern may also be applied to cover sheets and other objects

capable of being associated with a document (paragraph block 0035).

Klotz, Jr. et al. teach that document surrogate 80, as depicted, contains

summaries of four different documents. Each document summary contains document

selection box 82, first window 84, and second window 86. Second window 86 is

depicted as a nine window summary of the document and may contain reduced images

(Column 13, lines 55 – 62), which meet the limitation of **receiving an image of a**

document index, the document index comprising a plurality of graphic

representations of documents, wherein each graphic representation uniquely

identifies a document;

Klotz, Jr. et al. teach that selection box 82 is a way for a user to select a subset

of documents that are summarized on the surrogate. The document processing system

will then know to scan the image where selection boxes 82 are located and detect the

presence or absence of user supplied selections (Column 13, lines 63 – 67 and Column

14, lines 31 – 34), which meet the limitation of **locating, on the document index**

image, at least a first graphic representation of a first stored document.

Because both Davies et al. and Klotz, Jr. et al. teach methods of processing

coversheets, it would have been obvious to one of ordinary skill in the art at the time of

the invention to substitute one method for the other to achieve the predictable result of

processing a coversheet that represents a plurality of documents.

Regarding dependent claim 2:

Davies et al. teach that the present invention uses a scheme of encoded tags, such as adhesive stickers or labels (paragraph block 0012), which meet the limitation of **the first action sticker comprises a removable self-adhesive sticker.**

Regarding dependent claim 3:

Davies et al. do not explicitly teach **the first stored document is part of a stored collection of documents, and wherein the document index image comprises a collection coversheet image.**

Klotz, Jr. et al. teach that FIG. 4 shows a document surrogate that acts as a "document catalog". A document catalog is a document surrogate that contains summaries of more than one document. Document surrogate 80, as depicted, contains summaries of four different documents (Column 13, lines 52 – 56), which meet the limitation of **the first stored document is part of a stored collection of documents, and wherein the document index image comprises a collection coversheet image.**

Because both Davies et al. and Klotz, Jr. et al. teach methods of processing coversheets, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method for the other to achieve the predictable result of processing a coversheet that represents a plurality of documents.

Regarding dependent claim 4:

Davies et al. do not explicitly teach **the collection coversheet image comprises a collection overview image.**

Klotz, Jr. et al. teach that FIG. 4 shows a document surrogate that acts as a

"document catalog". Document surrogate 80, as depicted, contains summaries of four

different documents (Column 13, lines 52 – 56), which meet the limitation of **the

collection coversheet image comprises a collection overview image**.

Because both Davies et al. and Klotz, Jr. et al. teach methods of processing

coversheets, it would have been obvious to one of ordinary skill in the art at the time of

the invention to substitute one method for the other to achieve the predictable result of

processing a coversheet that represents a plurality of documents.

Regarding dependent claim 5:

Davies et al. do not explicitly teach **the collection overview image comprises a

plurality of thumbnail depictions of documents**.

Klotz, Jr. et al. teach that document surrogate 80, as depicted, contains

summaries of four different documents. Each document summary contains document

selection box 82, first window 84, and second window 86. Second window 86 is

depicted as a nine window summary of the document and may contain reduced images

(Column 13, lines 55 – 62), which meet the limitation of **the collection overview image

comprises a plurality of thumbnail depictions of documents**.

Because both Davies et al. and Klotz, Jr. et al. teach methods of processing

coversheets, it would have been obvious to one of ordinary skill in the art at the time of

the invention to substitute one method for the other to achieve the predictable result of

processing a coversheet that represents a plurality of documents.

Regarding **dependent claim 6**:

Davies et al. do not explicitly teach **the collection coversheet image comprises a machine-readable collection identifier specifying a storage location for the collection of documents, the method further comprising, prior to performing the specified first action: retrieving the identified first stored document from the specified storage location.**

Klotz, Jr. et al. teach that the presently preferred system comprises three levels of operations. The first and highest levels are system applications. The system applications include document storage, document retrieval, and the like (Column 10, lines 6 – 16), which meet the limitation of **the collection coversheet image comprises a machine-readable collection identifier specifying a storage location for the collection of documents, the method further comprising, prior to performing the specified first action: retrieving the identified first stored document from the specified storage location.**

Because both Davies et al. and Klotz, Jr. et al. teach methods of processing coversheets, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method for the other to achieve the predictable result of processing a coversheet that represents a plurality of documents.

Regarding **dependent claim 19**:

Davies et al. teach that exemplary services may include, but would not be limited

to, "scan to document repository," "scan and send via e-mail," "scan and fax," "scan and print copies," and so forth (paragraph block 0038), which meet the limitation of **the specified first action comprises one selected from the group consisting of: printing; e-mailing; faxing; grouping; reordering; playing; ungrouping; and deleting.**

Regarding dependent claim 20:

Davies et al. teach that an action processor reads the bitmap received from the scanner, identifies and decodes the glyph sticker, and accesses the database server to determine the identity of the user. The desired service may be inferred simply from the identity of the user (paragraph block 0044), which meet the limitation of **the specified first action comprises specifying an access level for the first stored document.**

Regarding dependent claim 27:

Davies et al. teach that based on the user's desired service, the action processor then causes the desired action to be performed, which may involve the generation of a transformed document by an output device. The output device is characterized generally here, but as discussed above, may comprise a hardcopy printer, a facsimile machine (or modem capable of sending fax messages), a network connection for e-mail, a connection to a document repository, a digital storage device or an aggregation of some or all of these and other functions (paragraph block 0045), which meet the limitation of **the specified first action comprises transmitting the identified first**

stored document to a destination, the method further comprising: determining a destination.

Regarding dependent claim 28:

Davies et al. teach that an exemplary data structure embodied by the glyph field includes a service code. Accordingly, the service code can represent up to 256 different possible actions, transformations, and services. Exemplary services may include, but would not be limited to, "scan to document repository," "scan and send via e-mail," "scan and fax," "scan and print copies," and so forth. An indicated service may, without limitation, include a plurality of actions (e.g., scan, then recognize characters, then e-mail the text), and may also involve transformation of the document from hardcopy to electronic form, and possibly back to hardcopy form (paragraph block 0038), which meet the limitation of **determining a destination comprises receiving user input specifying a destination.**

Regarding dependent claim 29:

· Davies et al. teach that an exemplary data structure embodied by the glyph field includes a service code. Accordingly, the service code can represent up to 256 different possible actions, transformations, and services. Exemplary services may include, but would not be limited to, "scan to document repository," "scan and send via e-mail," "scan and fax," "scan and print copies," and so forth. An indicated service may, without limitation, include a plurality of actions (e.g., scan, then recognize characters, then e-

mail the text), and may also involve transformation of the document from hardcopy to electronic form, and possibly back to hardcopy form (paragraph block 0038), which meet the limitation of **determining a destination comprises reading an indicator of a destination from the image of the document index.**

Regarding dependent claim 30:

Davies et al. teach that an exemplary data structure embodied by the glyph field includes a service code. Accordingly, the service code can represent up to 256 different possible actions, transformations, and services. Exemplary services may include, but would not be limited to, "scan to document repository," "scan and send via e-mail," "scan and fax," "scan and print copies," and so forth. An indicated service may, without limitation, include a plurality of actions (e.g., scan, then recognize characters, then e-mail the text), and may also involve transformation of the document from hardcopy to electronic form, and possibly back to hardcopy form (paragraph block 0038), which meet the limitation of **determining a destination comprises reading an indicator of a destination from the first action sticker.**

Regarding dependent claim 31:

Davies et al. teach that other services may require a differently coded argument (e.g., "scan and fax" followed by an argument of "2" may represent a command to fax the document to the user's home fax number, as opposed to an office fax number or, perhaps, an alternate office fax number, both of which would have different argument

numbers (paragraph block 0039), which meet the limitation of **determining a**
destination comprises determining at least one selected from the group
consisting of: an e-mail address; a fax number; a uniform resource locator; a
telephone number; and a mailing address.

Regarding dependent claim 32:

Davies et al. teach that an action processor reads the bitmap received from the
scanner (paragraph block 0044), which meet the limitation of **receiving an image of a**
document index comprises scanning the document index.

Regarding dependent claim 35:

Davies et al. teach that once the glyph sticker pattern has been located, the data
within the glyph field is then decoded. The data is then associated with a desired
service, and the service is performed (paragraph block 0052), which meet the limitation
of **determining the specified action by reading the first action sticker.**

Regarding dependent claim 36:

Davies et al. teach that it will be observed that any recoverable printed
representation of digital information, including but not limited to optically recognizable
alphanumeric characters can also be used in alternative embodiments of the invention
to similar effect (paragraph block 0036), which meet the limitation of **determining the**

specified action by performing optical character recognition on the first action

sticker.

Regarding dependent claim 37:

Davies et al. teach that it will be appreciated that minor variations of this method,

readily apparent to those skilled in the art, may also be used to identify and locate

various parallelogram, rhombus, trapezoid, and irregular quadrilateral patterns in

addition to rectangles and rectangle-like shapes (paragraph block 0072), which meet

the limitation of **determining the specified action by determining a shape of the first**

action sticker.

Regarding dependent claim 38:

Davies et al. teach that the method is operative on monochromatic images. If the

digitized image is in some other format (such as color or grayscale), it should first, as a

precursor to the method set forth in FIG. 6, be converted to a binary format, typically via

a threshold function or by dithering (paragraph block 0054), which meet the limitation of

determining the specified action by determining a color of the first action sticker.

Regarding dependent claim 39:

Davies et al. teach that the glyph sticker pattern includes several important

attributes. A glyph field contains a printed representation of digital data used to perform

the goals of the invention; it should be noted that the glyph field of FIG. 1 is shown as

using Xerox DataGlyphs (paragraph block 0036), which meet the limitation of

determining the specified action by reading a machine-readable icon on the first

action sticker.

Regarding dependent claim 43:

Davies et al. teach that the present invention uses a scheme of encoded tags,

such as adhesive stickers or labels, to serve as the primary user interface in a hardcopy

document processing system. Such a system would permit a user to specify an action

or a service to be performed simply by applying a sticker to the document and placing it

into a bin to be scanned (paragraph block 0012), which meet the limitation of **receiving**

input specifying an action comprises receiving input via a user interface.

Regarding claims 40 – 42, 44 – 49, 54, 55, 59 – 68, 73 and 74, the claims

incorporate substantially similar subject matter as claims 1 – 6, 19, 20 and 27 and are

rejected along the same rationale.

5.   Claims 7 – 18, 21 – 26, 33, 34, 50 – 53, 56 – 58, 69 – 72 and 75 – 79 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al. (US

20020085759 A1) and Klotz, Jr. et al. (US 5682540 A) and in further view of Cooper et

al. (5,680,223) and Cotte et al. (5,499,108).

Regarding **dependent claim 7:**

The rejection of claim 1 is incorporated herein by this reference. See also,

Cooper, col. 1, line 8 through col. 14, line 11, specifically, col. 10, lines 13-44, and col.

11, lines 5-12, teaching file manipulation.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 8**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cooper, col. 15, lines 1-4 teaching updating the index.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 9**:

The rejection of claim 1 is incorporated herein by this reference. See also,

Cooper, col. 15, lines 7-10 teaching storing the new file.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 10**:

The rejection of claim 1 is incorporated herein by this reference. Cooper, col. 1,

line 8 through col. 14, line 11, teaching updating the coversheet and locations

appropriate to the documents identified thereon.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 11**:

The rejection of claim 1 is incorporated herein by this reference. See also,

Cooper, Figure 13, teaching location and action stickers.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 12**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte,

col. 2, line 29 through col. 3, line 54, teaching multiple stickers and multiple "hot zones"

as proximate locations for stickers to be read in relation to each other.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 13**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte,

col. 2, line 29 through col. 3, line 54, specifically col. 18, line 64 through col. 19, line 35,

teaching the use of pointers with stickers.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 14**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte,

col. 2, line 29 through col. 3, line 54, specifically Figures 26 through 30, and col. 11, line

24 through col. 13, line 38, teaching the use of "hot zones" for location, along with

multiple actions stickers and pointers.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 15**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte, col. 2, line 29 through col. 3, line 54, specifically Figures 26 through 30, and col. 11, line 24 through col. 13, line 38, teaching location of the sticker or icon. It would have been obvious to one of ordinary skill in the art at the time of the invention to associate location with a coordinate. See also, Cooper, col. 10, lines 45-60.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 16**:

The rejection of claim 1 is incorporated herein by this reference. See also,

Cooper, figures 12 ad 13, teaching a list.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 17**:

The rejection of claim 1 is incorporated herein by this reference. The Examiner

takes official notice of the fact that "thumbnail" images were a well known and widely

used icons representing software applications and functions and it would have been

obvious to one of ordinary skill in the art at the time of the invention to use a thumbnail

representation of a document on a document image index coversheet for purposes of

giving visual cues to the user as to the content of the documents represented. See,

Bloomberg (U.S. Patent 5,761,686, issued June 2, 1998), col. 3, lines 7-31, teaching

that the use of thumbnail images as icons representing documents in applications and

functions was well known in the art at the time of the invention.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 18**:

The rejection of claim 1 is incorporated herein by this reference. See also,

Cooper, col. 1, line 8 through col. 14, line 11, teaching the use of icons on coversheets.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding **dependent claim 21**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte, col. 10, line 19 through col. 23, line 25, teaching the use of first and second stickers. See also, Cooper, figures 12 and 13, teaching multiple documents on a coversheet.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 22**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cooper, col. 3, line 23 through col. 4, line 59, teaching that a document to be retrieved from a storage device by a coversheet need not necessarily be an electronic document.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a
zero footprint of space consumed on the surface of a workstation (Cotte) and a method
and system for assigning a meaningful user-selected file label to files which uses
existing peripheral devices (Cooper).

Regarding **dependent claim 23**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte,
figures 28 and 30 teaching multiple actions.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it
would have been obvious to one of ordinary skill in the art at the time of the invention to
combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and
Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and
Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a
zero footprint of space consumed on the surface of a workstation (Cotte) and a method
and system for assigning a meaningful user-selected file label to files which uses
existing peripheral devices (Cooper).

Regarding **dependent claim 24**:

The rejection of claim 1 is incorporated herein by this reference. See also,
Cooper, col. 9, line 61 through col. 11, line 54, teaching "clipping" as a sub-collection
and performing actions user designated actions.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 25**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte, col. 10, line 19 through col. 23, line 25. See also, Cooper, col. 11, lines 13-31, teaching ordering of actions.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 26**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cotte,

col. 10, line 19 through col. 23, line 25. See also, Cooper, col. 10, line 19 through col.

23, line 25, teaching ordering of actions, the actions being sorted according to

identification order on the coversheet.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a

zero footprint of space consumed on the surface of a workstation (Cotte) and a method

and system for assigning a meaningful user-selected file label to files which uses

existing peripheral devices (Cooper).

Regarding dependent claim 33:

The rejection of claim 1 is incorporated herein by this reference. See also,

Cooper, col. 1, line 8 through col. 14, line 11, specifically, col. 13, lines 44-57, teaching

receipt of the image index from another computer, which includes via e-mail.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and

Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and

Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding **dependent claim 34**:

The rejection of claim 1 is incorporated herein by this reference. See also, Cooper, col. 1, line 8 through col. 14, line 11, specifically, col. 13, lines 44-57, teaching receipt of the image of the document via fax.

Although Davies et al. and Klotz, Jr. et al. do not explicitly teach the limitations, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Cooper et al. and Cotte et al. with that of Davies et al. and Klotz, Jr. et al. because such a combination would provide the users of Davies et al. and Klotz, Jr. et al. with the benefit of an input device using scanning technology that has a zero footprint of space consumed on the surface of a workstation (Cotte) and a method and system for assigning a meaningful user-selected file label to files which uses existing peripheral devices (Cooper).

Regarding claims 50 – 53, 56 – 58, 69 – 72, and 75 – 79, the claims incorporate substantially similar subject matter as claims 7 – 10 and 22 – 25 and are rejected along the same rationale.

Response to Arguments

6.   Applicant's arguments filed 10/30/07 have been fully considered but they are not

persuasive.

7.   In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

8.   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., comparison of the location of the sticker and the location of a graphic

representation of a document (p 25)) are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993).

9.   Further, it should be noted that the combination of Davies et al. and Klotz, Jr. et

al. meet all of the limitations of representative claim 1, since Klotz, Jr. et al. teach that

document surrogate 80, as depicted, contains summaries of four different documents.

Each document summary contains document selection box 82, first window 84, and

second window 86. Second window 86 is depicted as a nine window summary of the

document and may contain reduced images (Column 13, lines 55 – 62), which meet the

limitation of **receiving an image of a document index, the document index**

comprising a plurality of graphic representations of documents, wherein each

graphic representation uniquely identifies a document;

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nathan Hillery whose telephone number is (571) 272-

4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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